

Serial No. 10/670,523 2
Docket No. C14-161672M/ISI

REMARKS

Claims 1-24 are all of the claims presently pending in the application. Applicants have not amended the claims by the present response.

Applicants gratefully acknowledge the Examiner's indication that claim 9 is allowed.

Claims 23 and 24 stand rejected upon informalities (e.g., 35 U.S.C. § 112, first paragraph). Claims 1-8 and 10-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ito (U.S. Publication No. 2003/0103634) in view of Kowaki (U.S. Patent No. 7,218,740).

These rejections are respectfully traversed in the following discussion.

I. THE CLAIMED INVENTION

The claimed invention (e.g., as defined by claim 1) is directed to a play-back device.

The playback device includes a plurality of play-back sources, a first output unit and a second output unit for selecting at least one of the play-back sources to output play-back signals from the at least one of the play-back sources, a first operation unit for operations relating to the first output unit, a second operation unit for operations relating to the second output unit, a control unit for deciding whether the first output unit and the second output unit have selected a common play-back source and whether the play-back signals from the common play-back source are in an output-stopped state and for inhibiting the release of the output-stopped state from the second operation unit in response to the control unit deciding that the play-back signals from the common play-back source are in an output-stopped state, and a priority setting unit for setting a priority for the first operation unit and the second operation unit.

Accordingly, the claimed invention can reliably prevent play-back signals from a

Serial No. 10/670,523 3
Docket No. C14-161672M/ISI

common play-back source on the front side and the rear side from being released while the common play-back source is being selected (see Application at page 7, lines 14-20).

II. WRITTEN DESCRIPTION REQUIREMENT REJECTION

The Examiner alleges that the claimed invention of claims 23 and 24 was not described in the specification.

Applicants submit, however, that the specification provides support for *"wherein when the output-stopped state of the play-back signals is set in response to the interruption signal, the output-stopped state is not releasable by operation of the operation unit having a lower priority"* (as recited in claim 24) at page 53, lines 2-7.

Moreover, Applicants submit that the features recited in claims 23 and 24 are supported at page 47, line 22 through page 48, line 7).

Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw this rejection.

III. THE PRIOR ART REJECTION

The Examiner alleges that one of ordinary skill in the art would have combined Ito with Kowaki to teach the claimed invention of claims 1-8 and 10-24. Applicants submit, however, that these references would not have been combined as alleged by the Examiner and that, even if combined, the alleged combination of references would not teach or suggest each and every feature of the claimed invention.

That is, the alleged combination of Ito and Kowaki does not teach or suggest, *"a priority setting unit for setting a priority for the first operation unit and the second operation unit"*, as recited in exemplary claim 1, and similarly recited in exemplary claims 7, 8, 10, and

Serial No. 10/670,523 4
Docket No. C14-161672M/ISI

11.

The Examiner concedes that Ito does not teach or suggest a priority setting unit (see Office Action dated February 29, 2008 at page 4). The Examiner, however, alleges that Kowaki makes up the deficiencies of Ito.

Specifically, the Examiner alleges, "Kowaki teaches an audio system for use in the car with a priority setting unit for setting a priority for the first and second operation units." (See Office Action dated February 29, 2008 at page 4). Furthermore, the Examiner alleges, "it would have been within the level of skill in the art at the time of the invention was made (*sic*) to use a priority setting unit in Ito for setting a priority for the first and second operation units as claimed." (See Office Action dated February 29, 2008 at page 4).

Applicants submit, however, that the Examiner has failed to establish a *prima facie* case of obviousness.

Indeed, the rejection of record fails to satisfy *KSR*'s requirement that "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."

The rejection of record provides no more than "mere conclusory statements." Essentially, the method of evaluation in this rejection consists of nothing more than merely:

- Identifying a missing element (i.e., the priority setting unit);
- Describing a feature purportedly inherent in this missing element; and
- Summarily alleging that obviousness results because this inherent feature of this missing element would thereby be provided, in the abstract, by incorporating the missing element.

Serial No. 10/670,523 5
Docket No. C14-161672M/ISI

Specifically, the Examiner is alleging that one of ordinary skill in the art would have modified Ito to include a priority setting unit so that Ito could set a priority.

Applicants submit that this circular reasoning identified above is exactly the type of conclusory statements that the KSR holding expressly prohibits and constitutes an improper reasoning mechanism sometimes referred to in rhetoric as being a “tautology.”

The underlying fundamental logical flaw in this evaluation approach is that the feature purported to be inherent in this missing element is not realistically related back to the primary reference (e.g., Ito) and that the Examiner’s initial burden is not satisfied by simply pointing out features of the missing element, in the abstract, as done in the rejection of record.

In terms of the theory of argumentation, Applicants submit that the type of argument represented by the rejection of record, that of self-contained circular arguments that fail to relate back to the engineering reality of the primary reference and, instead, merely recite that the missing element has an inherent feature that would be present if the missing feature were to be mysteriously incorporated, in the abstract, into the primary reference, constitutes a tautology.

Stated slightly differently, the rejections of record fail to follow any of the seven rationales now identified in the beginning of MPEP §2143 and previously published by the USPTO in its October 10, 2007, Federal Register Notices, in the aftermath of KSR.

Presumably, based upon the reliance in the rejections upon purported benefits of missing elements, as best understood, the Examiner is attempting to invoke one or more of the rationales based upon either simple substitution or an improvement. However, these elements are either not simple substitutes or are incompatible with the primary reference or the alleged benefit does not apply to the environment of the primary reference or the missing element relied upon by the Examiner simply fails to satisfy the plain meaning of the claim language.

Serial No. 10/670,523 6
Docket No. C14-161672M/ISI

Moreover, Applicants submit that Kowaki, even if combined with Ito, fails to make up the deficiencies of Ito.

That is, Kowaki merely teaches a priority setting switch that determines a particular seat that receives optimum sound. The priority setting switch of Kowaki, however, does not set a priority for the first operation unit and the second operation unit, as Kowaki does not even include a first and second operation unit.

Thus, Kowaki fails to make up the deficiencies of Ito.

Therefore, Applicants submit that, even if combined, the alleged combination of references would not teach or suggest each and every feature of the claimed invention.

IV. FORMAL MATTERS AND CONCLUSION

In view of the foregoing, Applicants submit that claims 1-8 and 10-24, all of the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. Applicants respectfully request the Examiner to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, Applicants request the Examiner to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

Serial No. 10/670,523
Docket No. C14-161672M/ISI

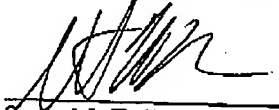
7

RECEIVED
CENTRAL FAX CENTER
MAY 29 2008

The undersigned authorizes the Commissioner to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Date: May 29, 2008

Respectfully Submitted,



Scott M. Tulino, Esq.
Registration No. 48,317

Sean M. McGinn, Esq.
Registration No. 34,386

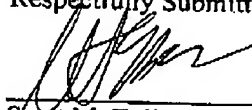
**MCGINN INTELLECTUAL PROPERTY
LAW GROUP, PLLC**
8321 Old Courthouse Road, Suite 200
Vienna, VA 22182-3817
(703) 761-4100
Customer No. 21254

FACSIMILE TRANSMISSION

I hereby certify that I am filing this paper via facsimile, to Group Art Unit 2627, at (571) 273-8300, on May 29, 2008.

Date: May 29, 2008

Respectfully Submitted,



Scott M. Tulino, Esq.
Reg. No. 48,317

Sean M. McGinn, Esq.
Reg. No. 34,386